

**REMARKS**

The above amendments and these remarks are responsive to the Office Action issued on October 20, 2004. By this response, claims 1, 5 and 6 are amended, and claims 2 and 7-15 are cancelled without prejudice. Dependent claim 16 is new. A replacement Fig. 1 is attached hereto. No new matter is added. Claims 1, 3-6 and 16 are now active for examination. A petition for a one-month extension of time is submitted concurrently herewith.

The Office Action dated October 20, 2004 rejected claims 1 and 3-7 under 35 U.S.C. §103(a) as being unpatentable over Takahashi et al. (U.S. Publication No. 2002/0071044) in view of admitted prior art. Claim 2 was rejected under 35 U.S.C. §103(a) as being unpatentable over Takahashi et al. in view of Jang et al. (U.S. Patent No. 5,200,828). Claim 8 stood rejected under 35 U.S.C. §103(a) as being unpatentable over Takahashi et al. in view of Soga et al. (U.S. Patent No. 5,376,964). The Office Action rejected claims 9 and 11-14 under 35 U.S.C. §103(a) as being unpatentable over Takahashi et al. in view of Ueda (U.S. Patent No. 5,212,557). Claim 10 was rejected under 35 U.S.C. §103(a) as being unpatentable over Takahashi et al. and Ueda and further in view of Jang et al. Claim 15 was rejected under 35 U.S.C. §103(a) as being unpatentable over Takahashi et al. and Ueda and further in view of Soga. The Examiner also objected to Fig. 1 for containing clerical errors.

It is submitted that the rejections are overcome and the objection is addressed in view of the amendments and remarks submitted herein.

**The Rejections of Claims 2 and 7-15 Are Now Moot**

By this Response, claims 2 and 7-15 are cancelled without prejudice. Accordingly, the rejections of claims 2 and 7-15 are now moot.

**The Obviousness Rejection of Claims 1 and 3-6 Is Traversed**

Claims 1 and 3-6 were rejected as being unpatentable over Takahashi in view of admitted prior art. The obviousness rejection is respectfully traversed because Takahashi and the admitted prior art cannot support a *prima facie* case of obviousness.

By this Response, claim 1 is amended and describes an apparatus for performing an automatic focus process based on images obtained under different exposure conditions. The apparatus generates a plurality of screens associated with a subject, wherein the plurality of screens are adjacent temporally and in different exposure conditions, and are used to form a synthesized image. Focal voltages associated with the plurality of screens are determined, and a focal voltage that is most suited to obtain a focus intended by the user is selected based on a predetermined selection criterion, to achieve automatic focusing in accordance with the selected focal voltage. Appropriate support for the amendment can be found in, for example, page 13, line 5 through page 14 line 9 of the written description.

However, Takahashi does not teach “focal voltage selecting means for selectively outputting one of said stored focal voltages that is most suited to obtain a focus intended by the user on the basis of a predetermined selection criterion,” as recited in claim 1. In rejecting claim 1, the Office Action merely replicated the claim language and asserted that Takahashi teaches this feature in paragraphs 49-53 and figures 1-3 without discussing which components in Takahashi correspond to the claimed element, and how components in Takahashi perform functions as described in claim 1. The paragraphs identified by the Examiner merely provide general descriptions related to automatic exposure (AE) control circuit 20 and automatic focus (AF) control circuit 22 and their respective control signals for preventing possible malfunctions caused by alternately outputting image signals obtained under different exposure conditions, such as 1/60 second or 1/1000 second. Although switches 29 and 30 are shown in the block

diagram in Fig. 2, the switches 29 and 30 are provided for selecting one of two available image signals. The selection has nothing to do with selecting and outputting a desired focal voltage that is most suited to obtain a focus intended by the user, as described in claim 1. Furthermore, nowhere does Takahashi describe selecting a suitable focal voltage based on a predetermined selection criterion, as described in claim 1.

These features also are unavailable in the admitted prior art.

Therefore, Takahashi and the admitted prior art, even combined, do not meet every limitation of claim 1. Accordingly, Takahashi and the admitted prior art cannot support a *prima facie* case of obviousness. The obviousness rejection is untenable and should be withdrawn. Favorable reconsideration of claim 1 is respectfully requested.

Claims 3-6 and 16 depend on claim 1 and incorporate every limitation thereof. Consequently, claims 3-6 are patentable over Takahashi and the admitted prior art for at least the same reasons as for claim 1.

Additionally, claims 3-6 further describe features that are unavailable in either Takahashi or the admitted prior art, and thus are patentable also based on their own merits. For instance, claim 4 describes that the focal voltage selecting means selectively outputs a focal voltage for focusing in accordance with magnitudes of said stored focal voltages inputted to the focal voltage selecting means. Claim 5 describes that the focal voltage selecting means selectively outputs a focal voltage for focusing on the basis of a comparison among luminance level frequency distributions associated with the obtained screens. Claim 6 is amended and describes that the focal voltage selecting means as recited in claim 1 varies the selection criterion in accordance with magnitudes of said stored focal voltages inputted to said focal voltage selecting

means and luminance level frequency distributions of the screens respectively associated with the focal voltages.

Appropriate support of the amendment to claim 6 can be found in, for instance, Fig. 8 and page 20, line 11 through page 21, line 7 of the written description. The subject matter of new dependent claim 16 is described in the specification, for example, at lines 20-24 of page 6.

Applicants submit that both Takahashi and the admitted prior art fail to teach or suggest the features as described in claims 3-6. Favorable reconsideration of claims 3-6 is respectfully requested.

**The Objection to Fig. 1 Is Addressed**

Fig. 1 was objected to for including clerical errors. By this Response, a replacement drawing is submitted to correct the errors identified by the Examiner. It is submitted that Fig. 1 is now in appropriate form.

For the reasons given above, Applicants believe that this application is conditioned for allowance and request that the Examiner give the application favorable reconsideration and permit it to issue as a patent. However, if the Examiner believes that the application can be put in even better condition for allowance, the Examiner is invited to contact Applicants' representatives listed below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Wei-Chen Nicholas Chen

Recognized under 37 CFR §10.9(b)

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
Phone: 202.756.8000 WC:apr:men  
Facsimile: 202.756.8087  
**Date: February 18, 2005**

**Please recognize our Customer No. 20277  
as our correspondence address.**

**AMENDMENTS TO THE DRAWINGS:**

Please replace Fig. 1 with the attached replacement drawing. Fig. 1 is amended to correct clerical errors as suggested by the Examiner. Specifically, different symbols are now used for “PERSON A” AND “PERSON B.” Furthermore, “IMAGE a” and “IMAGE b” in the original figure are replaced with “IMAGE Ia” and “IMAGE Ib.”